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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,040

05/06/2005

Tetsuya Yano

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LILLING, HERBERT J

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

06/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,040	Applicant(s) YANO ET AL.	
	Examiner HERBERT J. LILLING	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-12-09&3 IDS's [5-6-05;5-22-06;1-16-09].
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 2-7 and 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-7 and 13-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05-6-05;05-22-06;1-16-09</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Receipt is acknowledged of an election response filed May 12, 2009 for this Application which is a 371 of PCT/JP04/06349 filed April 30, 2004.

2. Claims 1-23 are present in this application.

3. Applicant has elected with traverse Invention I, claims 1-13 as noted:

Group I, claim(s) 1-13, **drawn to a structure** comprising a base material characterized in that the base material is coated at least partly with a polyhydroxyalkanoate containing at least one monomer unit selected from the group consisting of those represented by one of the chemical formulae [1] to [8], classified in Classes 435, 528, 428 or 430 depending upon the base material whether it is a particulate or a plate, subclasses 435/135; 528/271 428/800+ or 430/109.2 or 109.4 or 110.1 further depending upon the processes; which claimed subject matter for Invention I that is commensurate in scope with

the election of species which includes claims 1 and 8-12.

Thus, Claims 2-7 and 13-23 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Inventions and species elections, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 12, 2009. However, Applicant has not indicated any errors on the part of this Examiner that the restriction as well as the election of species was in error.

The Restriction and Election of species have been made **Final**.

4. In accordance with this Tech Center Policy based on above restriction containing **product claims and process claims**, this Examiner

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will rejoin any non-elected process claims upon the election of a product claim which is subsequently is found allowable in view of the following guidelines:

F.P.: Ochiai/Brouwer Rejoinder form paragraph

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8, 9 and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over :

a) claims 1, 2, 12, 14 and 15 of U.S. Patent No. 7,153,622;

or

b) claims 1,2 and 3 of U.S. Patent No. 6,853,477.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are within the claimed scope the instant claims.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

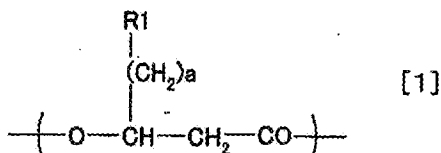
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- i) Ref N Nomoto et al EP 1253475 A2 Publication date October 2002
- ii) Ref O Nomoto et al EP 1254930 A2 Publication date November 2002;
or
- iii) Ref P Nomoto et al EP 1275728 A1 Publication date January 2003.

Each of the references teaches a structure within the scope of the claimed inventions which essentially recites:

1. A structure comprising a base material characterized in that the base material is coated at least partly with a polyhydroxyalkanoate containing at least one monomer unit selected from the group consisting of those represented by one of the chemical formulae [1] to [8]:



(wherein, the monomer unit is at least one selected from the group consisting of monomer units in which a combination of R1 and "a" is any one of combinations, wherein R1 is vinyl group; and "a" is an integer of 1 to 10),

Claim 8 . The structure according to claim 1, wherein

the base material is particulate.

9. The structure according to claim 8, wherein the base material contains a colorant.

10. A toner which contains the structure according to claim 8.

11. The structure according to claim 1, wherein the base material is in the form of flat plate or film.

12. The structure according to claim 1, wherein the monomer unit composition in the polyhydroxyalkanoate varies from the structure inside towards the outside of the structure.

REFERENCES DISCLOSES:

i) Ref N Nomoto et al EP 1253475 A2

As indicated in claims 1-3 a toner that comprises a colorant at least a part is covered with a PHA which PHA is the same as in formula (1) which reference is considered to anticipate claims 1, 8-10 and 12 as noted by Abstract of the cover sheet; paragraphs: [0081] of page 24; claims 1-3 of page 61 and claim 17 of page 17.

ii) Ref O Nomoto et al EP 1254930 A2

The reference teaches in claims 1 and 2 a PHA structure within the scope of the claimed language as indicated by Cover sheet whereby a base material is coated at least a part with a PHA; paragraphs [0002] of page 3 teaches a plate or film base material whereby PHA coats a granular base material which [0019] base material is a particulate that includes colorants which paragraph [0032] of page 8 teaches a monomer within the scope of the claims that coats the particulates and [0041] of page 15 teaches claim 12 structure and claims 1-2 teaches claim a structure within the scope of the claims.

iii. Ref P Nomoto et al EP 1275728 A

Nomoto et al teaches as indicated on the cover sheet Abstract that pigment particles are coated with at least a part of the surface with PHA which disclosure paragraphs [0029] on page 15 teaches claim 12 structure; [0050] on page 18 that the pigment includes colorants; [0074] the pigment and PHA layer which teaches claims 11-12 and claims 1-2 on page 44.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

i) **Ref N Nomoto et al EP 1253475 A2 Publication date Oct 2002;**

ii) **Ref O Nomoto et al EP 1254930 A2 Publication date Nov 2002;**

or

iii) **Ref P Nomoto et al EP 1275728 A1 Publication date Jan 2003.**

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The references each alone or further in view of each other teaches the claimed subject matter for claims 1 and 8-12 for the claimed structures as noted by the above disclosures in paragraph 6. If there are any differences with respect to the claimed structures absence a showing that these differences which includes the specific base material, specific colorant or type of base material.

In light of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc (TFX)* ., 82 USPQ2d 1385 (2007) based on the reasoning may still include the established Court of Appeals for the Federal Circuit standard that a claimed invention may be obvious if the examiner identifies a prior art teaching, suggestion, or motivation (TSM) to make it. However, the Guidelines explain that there is no requirement that patent examiners use the TSM approach in order to make a proper obviousness rejection. **Furthermore, the Guidelines point**

out that even if the TSM approach cannot be applied to a claimed invention that invention may still be found obvious.

If there are any differences with respect to the claimed subject matter and the general knowledge pertaining to the art in the area, that these differences would have been prima facie obvious to one of ordinary skill in the pertinent art whether it was based on the art of record or claimed subject would have obvious for the "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results".

Further in view of "In U.S. v Adams...." **Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the filed, the combination must do more than yield a predictable result."**; which is the same issue as in this application that the structure is not novel over the art of record.

Furthermore in view of ".Sakraida v. AG Pro Inc., ...**the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious."**

The Supreme stated the following:

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, 35 U.S.C. 103 bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve a similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

The KSR Decision requires rationales to support the rejections under 35 USC 103. The first issue is to analyze the Graham factual inquiry as noted above for obviousness based on the prior art but the prior art is not limited to references but includes the basic knowledge and understanding of one skill in the pertinent art. **Thus, the prior art alone or in combination does not have to teach or suggest or motivate one all of the limitations of the claimed limitations but there must be some rationale to explain these differences would have been obvious to one of ordinary skill in the art.**

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8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HERBERT J. LILLING whose telephone number is 571-272-0918. The examiner can normally be reached on WORK AT HOME MAXIFLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JON WEBER can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.J.Lilling: HJL
(571) 272-0918

Art Unit **1657**
June 21, 2009

/HERBERT J LILLING/
Primary Examiner Art Unit 1657